



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/677,011

09/30/2003

Andrew R. Ferlitsch

10237.34

7263

65400

7590

06/18/2009

KIRTON & MCCONKIE

1800 EAGLE GATE TOWER / 60 EAST SOUTH TEMPLE

P.O. BOX 45120

SALT LAKE CITY, UT 84145-0120

EXAMINER

HUNTSINGER, PETER K

ART UNIT

PAPER NUMBER

2625

MAIL DATE

DELIVERY MODE

06/18/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/677,011

Applicant(s)

FERLITSCH, ANDREW R.

Examiner

Peter K. Huntsinger

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/10/09 has been entered.

Response to Arguments

2. Applicant's arguments filed 6/10/09 have been fully considered but they are not persuasive.

The applicant argues on page 10 of the response in essence that:
Simpson '803 does not disclose rendering the print job using the identified default device setting set without further preparation of the print data regardless of the default print setting set selected.

a. Frolik '804 discloses rendering the print job using the identified default device setting set (col. 9, lines 10-13, the document content 212 that is sent to the printer may be rendered to allow printing). Simpson '803 discloses rendering the print job without further preparation of the print data (see abstract, col. 1, lines 39-51, computer generates a print job without the use of a print driver).

The applicant argues on page 10 of the response in essence that:

Simpson '803 does not disclose that no further preparation of the print data occurs.

b. Simpson '803 discloses that the computer generates a print job without conversion by a printer driver (see abstract, col. 1, lines 39-51). After the print job is rendered, it is transmitted to the printer for printing (col. 14, lines 19-26).

The applicant argues on page 11 of the response in essence that:

The proposed motivation for combining Frolik '804 and Scheidig '565 of storing data locally to increase retrieval speed would not be achieved by adding the features of Scheidig '565 to Frolik '804, as Frolik '804 already discloses that setting sets are stored locally.

c. At the time of the invention, it would have obvious to a person of ordinary skill in the art to store printer settings in the memory of the printer. The motivation for doing so would have been to allow the printer to have faster access to the printer settings to increase retrieval speed and shorten access time.

The applicant argues on page 11 of the response in essence that:

There is no motivation for combining Simpson '803 with Frolik '804 because Frolik '804 is directed to local printing of remotely-stored documents.

d. At the time of the invention, it would have obvious to a person of ordinary skill in the art to generate a document without using a printer driver. The

motivation for doing so would have been to eliminate the need to specifically configure a computer to make use of many printers. Merely because Frolik '804 is directed to local printing does not preclude the system from incorporating more than one local printer.

The applicant argues on page 12 of the response in essence that:

Frolik '804 does not disclose wherein the characteristic is one of: (i) a job name; (ii) a user name; (iii) an account code; and (iv) a department code.

e. Frolik '804 discloses that printer settings are selected with preference given to move narrowly-applicable sets of settings such as document-specific settings [i.e. unique to the individual print job]. (col. 8, lines 15-33). A document in the system of Frolik '804 is inherently identified by its file name.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 14-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 14-20 are directed to a computer readable medium. The applicant's specification states:

It is typically processing system 14 that executes the instructions provided on computer readable media, such as on memory 16, a magnetic hard disk, a removable magnetic disk, a magnetic cassette, an optical disk, or from a

communication connection, which may also be viewed as a computer readable medium.

(page 13, lines 11-14)

Thus, in light of the specification, the recited computer readable medium encompasses a communication connection. A communication connection or signal is not patentable subject matter falling within any statutory category under § 101. Therefore, claims 14-20 are non-statutory.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-4, 9, 10, 14-17, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frolik '804 in view of Scheidig '565 and Simpson '803.

Referring to **claims 1 and 14**, Frolik '804 discloses in a printing environment, a method for specifying application specific printing requirements for an arbitrary printing device, the method comprising:

providing a printing device having a plurality of default device setting sets (col. 2, lines 18-26, printer settings);

configuring one of the default device setting sets by selectively associating an application specific name with one of:

(i) a standard default setting set;

(ii) an application specific default setting (col. 2, lines 3-10, user-selected sets are associated with the application or globally associated with the computer system);

identifying which of the default device setting sets are to be used in rendering a particular print job (block 349 of Fig. 6, col. 9, lines 22-34, checks for application specific printer settings); and

rendering the print job using the identified default device setting set regardless of the default print setting set selected (col. 9, lines 10-13, the document content 212 that is sent to the printer may be rendered to allow printing).

Frolik '804 does not disclose expressly storing the plurality of default device setting sets in the memory of the printing device.

Scheidig '565 discloses having a plurality of default device setting sets stored in memory of the printing device (col. 3, lines 51-67, 1-2, printer includes control panel which stores plurality of setup data sets [see Fig. 2] comprising control data).

At the time of the invention, it would have obvious to a person of ordinary skill in the art to store printer settings in the memory of the printer. The motivation for doing so would have been to allow the printer to have faster access to the printer settings to increase retrieval speed and shorten access time.

Frolik '804 does not disclose expressly rendering the print job without further preparation of the print data regardless of the default print setting set selected.

Simpson '803 discloses rendering the print job without further preparation of the print data (col. 1, lines 39-51, computer generates a print job without the use of a print driver).

At the time of the invention, it would have obvious to a person of ordinary skill in the art to generate a document without using a printer driver. The motivation for doing so would have been to eliminate the need to specifically configure a computer to make use of many printers. Therefore, it would have been obvious to combine Scheidig '565 and Simpson '803 with Frolik '804 to obtain the invention as specified in claims 1 and 14.

Referring to **claims 2 and 15**, Frolik '804 discloses wherein the plurality of default device setting sets comprise:

- (i) a factory default setting set;
- (ii) the standard default setting set; and
- (iii) the application specific default setting set (col. 5, lines 6-16, default preferences).

Referring to **claims 3 and 16**, Frolik '804 discloses wherein identifying which of the default device setting sets are to be used in rendering a particular print job is performed based on a characteristic of the print job (block 349 of Fig. 6., col. 9, lines 22-34, document and application specific printer settings).

Referring to **claim 4**, Frolik '804 discloses the characteristic is one of:

- (i) a job name;
- (ii) a user name;

(iii) an account code; and

(iv) a department code (col. 8, lines 15-33, printer settings selected with preference given to move narrowly-applicable sets of settings such as document-specific settings [i.e. unique to the individual print job]).

Referring to **claims 9 and 19**, Frolik '804 discloses associating an application specific name with the application specific default setting to create a named default setting (col. 2, lines 3-10, user-selected sets are associated with the application); and

allowing the standard default setting set to be unchanged (col. 7, lines 50-55, user need not change the global printer settings).

Referring to **claims 10 and 20**, Frolik '804 discloses configuring the print job based on the named default setting; and

modifying the named default setting by a job specific setting (block 343, col. 9, lines 14-21, document specific printer settings).

Referring to **claim 17**, Frolik '804 discloses wherein the characteristic is one of (i) a job name, (ii) a user name, (iii) a document name, (iv) an account code, and (v) a department code (col. 9, lines 22-34, document specific printer settings).

7. Claims 5, 6 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frolik '804, Scheidig '565 and Simpson '803 as applied to claim 1 above, in further view of Cartier '654.

Referring to **claims 5 and 18**, Frolik '804 discloses configuring the default device setting set, but does not disclose expressly configuring one of the default device setting sets using a pseudo print job.

Cartier '654 discloses configuring a device setting using a pseudo print job and wherein the pseudo print job includes one or more commands that instruct the printing device to change and store in the memory of the printing device a setting of the default device setting set being configured (col. 8, lines 16-40, a user may modify a printer setting through a PJI command [i.e. a print job language command without print job data]).

At the time of the invention, it would have obvious to a person of ordinary skill in the art to configure a printer setting using a PJI command. The motivation for doing so would have been to utilize a widely used high level printer language that can query or modify the value of certain printer settings.

Referring to **claim 6**, Cartier '654 discloses wherein the one or more commands comprises a print job language DEFAULT command (col. 8, lines 16-40, PJI command modifies the font priority print setting).

8. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Frolik '804, Scheidig '565 and Simpson '803 as applied to claim 1 above, and further in view of Taniguchi '707.

Referring to **claim 7**, Frolik '804 discloses utilization of the application specific default setting, but does not disclose expressly an authentication procedure.

Taniguchi '707 discloses an authentication procedure (\$609 of Fig. 6, col. 7, lines 21-23, user inputs password).

At the time of the invention, it would have obvious to a person of ordinary skill in the art to perform an authentication procedure. The motivation for doing so would have been to allow the user to keep desired information secret. Therefore, it would have been obvious to combine Taniguchi '707 with Frolik '804 to obtain the invention as specified in claim 7.

9. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Frolik '804, Scheidig '565 and Simpson '803 as applied to claim 1 above, and further in view of admitted prior art.

Referring to **claim 8**, Frolik '804 discloses the application specific default setting but does not disclose expressly using a flag to prevent the application specific default setting from being changed.

Official Notice is taken that it is well known and obvious at the time of the invention to utilize a flag to prevent information from being changed (See MPEP 2144.03).

The motivation for doing so would have been to prevent unintentionally changing information. Therefore it would have been obvious to combine well known prior art with Frolik '804 to obtain the invention as specified in claim 8.

10. Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frolik '804 in view of Scheidig '565, Hawes '436 and Simpson '803.

Referring to **claim 11**, Frolik '804 discloses a printing device comprising: a plurality of default device setting sets (col. 2, lines 18-26, printer settings) wherein the default device setting sets are configured by selectively associating an application specific name with one of (i) a standard default setting set and (ii) an application specific default setting (col. 2, lines 3-10, user-selected sets are associated with the application or globally associated with the computer system), and wherein one of the default device setting sets is selected based on a characteristic of a particular print job and used at the printing device in rendering the particular print job (block 349 of Fig. 6, col. 9, lines 22-34, checks for application specific printer settings), wherein the characteristic is one of: (i) a job name; (ii) a user name; (iii) an account code; and (iv) a department code (col. 8, lines 15-33, printer settings selected with preference given to move narrowly-applicable sets of settings such as document-specific settings [i.e. unique to the individual print job]).

Frolik '804 does not disclose expressly storing the plurality of default device setting sets in the memory of the printing device.

Scheidig '565 discloses having a plurality of default device setting sets stored in memory of the printing device (col. 3, lines 51-67, 1-2, printer includes control panel which stores plurality of setup data sets [see Fig. 2] comprising control data).

At the time of the invention, it would have obvious to a person of ordinary skill in the art to store printer settings in the memory of the printer. The motivation for doing so

would have been to store data locally to increase retrieval speed and shorten access time.

Frolik '804 does not disclose expressly configuring the default device setting sets with an embedded device web page.

Hawes '436 discloses configuring device settings with an embedded device web page (Fig. 4, col. 8, lines 3-30, devices 102, 106 includes services for setting properties with a browser).

At the time of the invention, it would have obvious to a person of ordinary skill in the art to configure device settings using an embedded webpage. The motivation for doing so would have been to provide a more convenient method for the user to modify printer settings.

Frolik '804 does not disclose expressly rendering the print job without further preparation of the print data regardless of the default print setting set selected.

Simpson '803 discloses rendering the print job without further preparation of the print data (col. 1, lines 39-51, computer generates a print job without the use of a print driver).

At the time of the invention, it would have obvious to a person of ordinary skill in the art to generate a document without using a printer driver. The motivation for doing so would have been to eliminate the need to specifically configure a computer to make use of many printers. Therefore, it would have been obvious to combine Scheidig '565, Hawes '436 and Simpson '803 with Frolik '804 to obtain the invention as specified in claim 11.

Referring to **claim 12**, Frolik '804 discloses wherein the plurality of default device setting sets comprise:

- (i) a factory default setting set;
- (ii) the standard default setting set; and
- (iii) the application specific default setting set (col. 5, lines 6-16, default preferences).

Referring to **claim 13**, Frolik '804 discloses wherein the print job is one of:

- (i) a fax job;
- (ii) a scan job;
- (iii) a copy job; and
- (iv) a document management job (col. 2, lines 27-31, document retrieval).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter K. Huntsinger whose telephone number is (571)272-7435. The examiner can normally be reached on 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571)-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Peter K. Huntsinger/
Examiner, Art Unit 2625

/David K Moore/
Supervisory Patent Examiner, Art Unit 2625